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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,079	01/14/2004	Michael Ian Birrell	797.005	5345
23598	7590	09/12/2007		
BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203			EXAMINER EDWARDS, NEWTON O	
			ART UNIT 1774	PAPER NUMBER
			NOTIFICATION DATE 09/12/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

## Office Action Summary

Application No.

10/757,079

Applicant(s)

BIRRELL, MICHAEL IAN

Examiner

N Edwards

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/21/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1774

Applicant argues 1) the restriction without addressing the subject matter of the groups and amend the claims with New matters (single consolidation and multilayer are joined together to form a whole with pointing out support), then concludes he is uncertain how the restriction analysis of group I and group II renders the claims set patentably distinct.

Applicant has failed to address what the claimed invention is of Group I and Group II as now amended and how they cover the same subject matter without an undue burden of the Examiner. The restriction of record addresses the claims before applicant amended (New Matter) to his case. The process of making of group II has a separate classification in class 264, which produces an undue burden of the examiner. Further, the product of group I and the process of group I has an acquired a separate status in the art due to their different classification and divergent subject matter.

Applicant concludes 2) neither Claim 1 as amended nor claims 12 as amended claim a variant of the process. The similarities of group I as amended and group II as amended cannot be ignored.

See above for response. The restriction is deemed proper and hereby made FINAL.

Group I, claims 1-11, 15, 16, and 18 will be examined.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1774

The specification as filed is objected to for failing to provide support for the invention as is now claimed.

The specification as filed fails to provide support for 1) Claim 1, line 6 "to form a single consolidated product" and 2) Claim 15, line 9 "are consolidated to form a generally a whole".

Claims 1-11, 15, 16, and 18 are rejected under 35 USC 112, first paragraph, for the reasons given in the objection above.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification as filed 1) fails to provide an adequate written description of the invention and 2) failing to provide an enabling disclosure.

The specification as filed 1) fails to provide any written description for Claim 1 line 6 "to form a single consolidated product", 2) fails to provide any written description for claim 15, line 9 "a painted multilayer product .. are consolidated to form generally a whole", 3) what temperature and pressure are use to make a single consolidated product ( or consolidated to from a generally a whole) of claim 1 and claim 15 , 4) What defines or constitute the phrase consolidated to form generally a whole, 5) How to make the single consolidated product (or consolidated to form generally a whole) of claims 1 and 15, 6) what is the final structure of a mold having a desired shape of claim 18 ?, 7) what

Art Unit: 1774

defines or constitute multiple cover layers to be different so as to be considered isotropic in claim 18? what makes them different and who considered them (subjective) isotropic, 8) what defines or constitute the very low thermal coefficient of thermal expansion in claim 18, 9) what defines or constitute the product low density of claim 18? , and 10) what defines or constitute surface quality, good surface quality, and great stiffness of claim 18.

The specification also fails to provide any guide or direction of how to make a single consolidated product (or consolidated to from generally a whole) of claims 1 and 15 and what temperature and pressures are used to form the single consolidated product. The specification has no working examples of how a single consolidated product (or consolidated to form a generally a whole) of claims 1 and 15. The specification at page 2 lines 16-17 and page 5 lines 1-6 fails to disclose the final product structure.

3. Claims 2-11, 18 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. The final product form by claim 1 and 15 is a single consolidated product (or consolidated to from generally a whole) thus the cover layer and the substrate (intermediate product) are no longer present when the final product is formed.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

Art Unit: 1774

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 11/572,297. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant filed genus and species claims in 11/572,297 and 10/757079. Thus obviousness-type double patenting is met since the genus claims include the species claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-11,15,16,and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 15 are overall vague and indefinite since they omit any transitional phrase.

Claim 1, line 4 "preferably less than 1.0 g/cm cube" is vague and indefinite as to the meaning of the claim since the claim contains a double inclusion (two limitations for density). See claim 15 lines 3 and 4 for the same problem.

Claims 2-11, 16, and 18 are indefinite and vague since the claims fail to further limit the single consolidated product (final product) of claims 1 and 15. The substrate and the cover layer (intermediate products) are no longer present when the final product is formed.

Claim 15, line 9 "consolidated to from generally a whole" is vague and indefinite as to the meaning of the phrase.

Claim 15 overall is indefinite and vague because 1) the preamble of the claim is a painted multilayer product while the final product is a 9 "consolidated to from generally a whole", thus the preamble of claim 15 and body of the claim are not commensurate in scope. 2) Claim 15 is further indefinite since the body of the claim fails paint and the location of such paint on the final product and intermediate product (cover layer and substrate).

Claim 18, line 3 "different so as to be considered isotropic" is indefinite and vague as to how the cover layers are different and "so as to be considered isotropic" is a indefinite since this a subjective limitation which can change from person to person.

Claim 18 line 5 "...coefficient of thermal expansion is very low" is vague and indefinite as to the meaning of the phrase.

Art Unit: 1774

Claim 18, line 8 "... the product has low density, great stiffness and good surface quality is vague and indefinite as to the meaning of the phrase.

The cited patents disclose the state of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to N Edwards whose telephone number is 571-272-1521. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



N Edwards  
Primary Examiner  
Art Unit 1774